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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,527	10/25/2002	Carl Michael Dennison	BLD920010034US2	2144
33595	7590	08/26/2005	EXAMINER	
INTERNATIONAL BUSINESS MACHINES CORPORATION 9000 SOUTH RITA ROAD TUCSON, AZ 85744			HUNTSINGER, PETER K	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 08/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/065,527

Applicant(s)

DENNISON ET AL.

Examiner

Peter K. Huntsinger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/16/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Objections

1. Claim 9 is objected to because of the following informalities: On page 8 of the claims, the phrase "executing on a processors" should be changed to "executing on a processor". Appropriate correction is required.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 4 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is insufficient disclosure relating to the unseen marker. The specification provides no details on the step of removing the unseen marker nor does it describe locating the unseen marker.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language..

4. Claims 1, 3-5, 9, and 11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Livingston U.S. Patent 6,614,454.

Referring to claims 1 and 9, Livingston discloses a method comprising: displaying a plurality of original document visual objects of an original document (print preview image 68 of Fig. 3A, col. 5, lines 38-39); inserting into the original document a plurality of visual cue objects corresponding to print job ticketing parameters, thereby creating an amended document (staples 69 of Fig. 3A, col. 5, lines 38-39), and displaying the plurality of visual cue objects (S5 of Fig. 2, col. 4, lines 2-6); and removing from the amended document, for specific operations to be performed on the amended document, at least one of the plurality of visual cue objects (staples 69 of Fig. 3A, col. 5, lines 38-39) and performing the specific operations ("Staple this Job Using" of Fig. 3A, col. 5, lines 17-20). When the user deselects "Staple this Job Using", the staples displayed on print preview image 68 will be removed.

Referring to claims 3 and 11, Livingston discloses removing from the amended document, for printing to be performed on the amended document, at least one of the plurality of visual cue objects (staples 69 of Fig. 3A, col. 5, lines 38-39) and performing the printing ("Print" of Fig. 3A, col. 5, lines 17-20). When the user prints the document,

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the staples displayed on print preview image 68 showing where the staples will appear are not be printed and must be removed prior to printing.

Referring to claims 4 and 12, Livingston discloses the method of claim 1 wherein said step of inserting further includes inserting an unseen marker with each of the plurality of visual cue objects and wherein said step of removing the at least one of the plurality of visual cue objects further includes locating the unseen marker. It is inherent that the program of Livingston needs to track of whether the option for staples has been selected or not. A register or variable present in the program code indicates the selection of the user and is an unseen marker. The selection or deselection of the "Staple this Job Using" button would require locating the register or variable to record the result.

Referring to claims 5 and 13, Livingston discloses the method of claim 1 wherein said step of inserting further includes maintaining a list of each of the plurality of visual cue objects inserted (col. 5, lines 20-27) and wherein said step of removing the at least one of the plurality of visual cue objects further includes referencing the list and identifying the at least one of the plurality of visual cue objects to be removed. As is shown in Fig. 3A of Livingston, the option of stapling is provided sequentially in a list format. The user is able to visibly view the list and determine which staples that are desired to be removed.

Claim Rejections - 35 USC § 103

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Livingston U.S. Patent 6,614,454 as applied to claim 1 above, and further in view of Moore U.S. Patent 6,880,124.

Referring to claims 2 and 10, Livingston discloses removing from the amended document, for printing to be performed on the amended document, at least one of the plurality of visual cue objects (staples 69 of Fig. 3A, col. 5, lines 38-39) and performing the printing ("Print" of Fig. 3A, col. 5, lines 17-20). When the user prints the document, the staples displayed on print preview image 68 showing where the staples will appear are not be printed and must be removed prior to printing. Livingston does not disclose expressly the specific operation of saving. Moore discloses automatically saving a document when printing (col. 7, lines 12-18). Livingston and Moore are combinable because they are from the same field of printing systems. At the time of the invention, it would have been obvious for a person of ordinary skill in the art to automatically save a document when printing. The motivation for doing so would have been to create a backup file for printed documents in case the user's file is not printed correctly or further copies are desired. Therefore, it would have been obvious to combine Moore with Livingston to obtain the invention as specified in claims 2 and 10.

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7. Claims 6-8 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Livingston U.S. Patent 6,614,454 as applied to claim 1 above, and further in view of Simpson et al. Publication US 2002/0184305.

Referring to claims 6 and 14, Livingston discloses the steps of inserting and removing but does not disclose expressly the steps being performed by a plug-in to a document editor. Simpson et al. disclose plug-in to a document editor providing a plug-in interface (page 1, paragraph 3). Livingston and Simpson et al. are combinable because they are from the same field of print previewing programs. At the time of the invention, it would have been obvious for a person of ordinary skill in the art to apply the print preview program of Livingston as a plug-in to a document editor. The motivation for doing so would have been to increase the flexibility of a program by allowing its incorporation into other programs. Therefore, it would have been obvious to combine Simpson et al. with Livingston to obtain the invention as specified in claims 6 and 14.

Referring to claims 7 and 15, Livingston discloses applying certain of the print job ticketing parameters to all pages of the document ("Apply changes to: All Pages" of Fig. 3B).

Referring to claims 8 and 16, Livingston discloses applying certain of the print job ticketing parameters to selected pages of the document ("Apply changes to: All Pages" of Fig. 3B). The changes are shown to apply to selecting all pages.

Conclusion

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8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Livingston U.S. Patent 6,621,590.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PKH



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